REMARKS

The foregoing Amendments to the Claims are formatted according to the Revised Amendment Format and therefore no "marked-up" version of the claims is provided.

Reconsideration and allowance of this Application are respectfully requested in light of the foregoing amendments and the following remarks.

Claims 1-26 are pending in the Application.

Claims 1, 2, 4-7, 10-12, and 14 have been amended to overcome informalities objected to by the Examiner, to broaden the scope of some of the claims, to clarify the claim language, and to conform these claims to U.S. practice as follows:

Claim 1 - the preamble is amended to recite "at least one" supplier as antecedent basis for the "plurality of suppliers" recited by claim 6;

Claim 2 - is amended to recite "system" instead of "organization" because this replacement of "organization" with "system" was inadvertently overlooked in the prior Amendment and to recite "a knowledge base comprising a plurality of predetermined relationships and a plurality of predetermined rules" to provide proper antecedent basis for the recitation of "said predetermined rules" and "said predetermined relationships" in claim 3, and to replace the language "predetermined rules stored within said knowledge base".

Claim 4 - the modifier "at least one" is added to supplier to conform the claim language to U.S. practice since the antecedent in claim 1 now recites "at least one supplier."

Claim 5 - "including" is replaced by "further comprising" to broaden the claim's scope.

Claim 6 - the language "predetermined relationships comprise class and attribute characteristics" provides proper antecedent basis for the subsequent recitation in this claim of

"identical class and attribute characteristics," the language "said at least one supplier is a plurality of suppliers, said suppliers reviewing ... normalizing" conforms the claim language to U.S. practice, the replacement of "organization" with "system" overcomes the objection of the Examiner resulting from the inadvertent overlooking of this change that was necessitated by the prior amendment of claim 1, and recitation of "identical class and attribute characteristics" replaces "identical classes and attributes" to conform the claim language to U.S. practice.

Claim 7 - "said at least one supplier is" replaces "suppliers" to conform the claim language to U.S. practice with respect to the antecedent reference to claim 1, "system" replaces "organization" to overcome the objection of the Examiner resulting from the inadvertent overlooking of this change that was necessitated by the prior amendment of claim 1, and "a plurality of said suppliers" is replaced by "said at least one supplier" to conform the claim language to U.S. practice.

Claim 10 -"comprising at least one unique catalog item" provides proper antecedent basis for the subsequent recitation of "each unique catalog item" in the first limitation, "comprising" replaces "including" to broaden the second limitation, and the recitation that the item specifying procedure is invoked "by said item selection procedure" is added to clarify the final limitation of this claim.

Claim 11 - "comprises" and "comprising" replace "includes" and "including" to broaden the scope of this claim, and the "creation of ... being" language clarifies the claim language.

Claim 12 - the claim language is conformed to U.S. practice by reciting that "said structured requisition further comprises identification of at least one supplier"and that requisitions are automatically sent to "said identified at least one supplier."

Claim 14 - the language "at least one" has been added to modify "new predetermined rule" to conform the claim language to U.S. practice where the antecedent for this language is provided by claim 13.

Claim 20 - "system" is replaced by "method" to conform to U.S. practice for a method claim, and the final four steps of the method are limited to performance for an item that is not within said database.

Claim 21 - "system" is replaced by "method" to conform to U.S. practice for a method claim.

Claim 22 - "system" is replaced by "method" to conform to U.S. practice for a method claim.

Claim 23 - "system" is replaced by "method" to conform to U.S. practice for a method claim.

Claim 24 - "system" is replaced by "method" to conform to U.S. practice for a method claim. and the updating step has been rephrased for clarity.

Claim 25 - "system" is replaced by "method" to conform to U.S. practice for a method claim, and "includes" has been replaced by "comprises" to broaden the scope of the claim.

Claim 26 - "system" is replaced by "method" to conform to U.S. practice for a method claim. No new matter is added by any of these amendments to the claims.

Claim Rejections

1. Claims1-26 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

The Examiner alleges that in the present case, claims 1-26 do not explicitly recite technological limitations in the body of the claims and refers Applicants to *Ex parte Bowman, 61 USPQ2d 1669 (BdPatApp&Int 2001).*

Applicants respectfully traverse. The Examiner has mis-characterized the claims and misinterpreted the citation. Unlike Bowen where there is no recitation in the claims or disclosure

of technological limitations or technology, respectively, here, both the disclosure and, independent Claims 1 and 10 after their preambles clearly specify hardware, software, or both.

A. Claim 1

Claim 1 recites "a fulfillment system for communicating between said buyer and said supplier" and the specification, (referring to this fulfillment system as a "back office 24") discloses that the buyer 22 communicates with the back office 24 to search or select item information and to place an order, the back office 24 having one or more databases 32 to facilitate the item order process, and the specification further discloses that back office 24 communicates with suppliers 26 on behalf of buyer 22 to get information not in its databases 32 or to forward an order received from buyer 22, thus fulfilling the order as shown by line 36. FIG. 1 illustrates this claimed communicating by the back office between said buyer and said supplier (Specification page 6, lines 10-20 and FIG. 1). The limitations of Claim 1 which recite a fulfillment system communicating between suppliers and buyers and a database associated with said fulfillment system clearly is within both the hardware and software technological arts and thus recite technological limitation in the body of Claim 1, contrary to the allegation of the Examiner. Therefore, Claim 1 and Claims 2-9 dependent therefrom, are directed to statutory subject matter and the rejection should be withdrawn.

B. Claim 10

Claim 10 recites, *inter alia*, a procurement system comprising a normalized catalog database wherein unique catalog items are stored and identified with respect to class, attribute and value relationships; a knowledge base comprising a set of predetermined rules used to convert free form catalog item information into said normalized catalog database in accordance with said class, attribute and value relationships; and an item selection procedure relying on said relationships for

locating a desired item within said catalog database. The disclosure is replete with examples of the network, hardware, and software technology that can be used to carry out the invention of Claim 10. A typical selection procedure is described therein as taking advantage of the normalized catalog database in which items are uniquely identified using class/attribute/value relationships which allows drilling down through various classes that are presented in a hierarchical format such as that illustrated in FIG. 5 wherein selecting a class results in presentation of the sub-class under it and selection of the sub-class results in presentation of the sub-sub-class and so on until a leaf class is selected (Specification page 8 line 19 through page 9 line 4). FIG. 7 illustrates selection using the claimed selection procedure in which *hyperlinks* are associated with specific items (Specification page 10, line 7 et seq). Alternatively, a text based search is described (Specification page 8, line 7 et seq.) with reference to the displays/screens illustrated in FIGs. 3 and 5. A detailed flow of the procurement system for purchasing a desired item comprising a catalog database and an item selection procedure is illustrated in FIG. 2 and described at specification page 6, line 21 et seq. A functional overview of the procurement system claimed by Claim 10 is illustrated in FIG. 10 wherein a normalized database 32, knowledge base 30, item selection procedure 204 and item specifying procedure 208 along with structured requisition 210 correspond to the recited elements of Claim 10.

The limitations of Claim 10, which recite a normalized catalog database and an associated knowledge base comprising rules used to convert free form catalog item information into said normalized catalog database, are clearly within both the hardware and software technological arts and thus recite technological limitations in the body of Claim 10, contrary to the allegation of the Examiner. Therefore, Claim 10 is directed to statutory subject matter and Claims 11-16 dependent

therefrom are directed to statutory subject matter for at least this reason and the rejections of these claims should be withdrawn.

C. Claim 17

Claim 17 is a method for continuously updating a normalized database using a knowledge base of rules. For the same reasons as set forth above for Claim 10, the steps of present independent method Claim 17 are directed to statutory subject matter and Claims 18-19 dependent therefrom are directed to statutory subject matter for at least this reason, and the rejections of these claims should be withdrawn.

D. Claim 20

Claim 20 is a method for ordering a special item comprising steps which search a database, determine the item is not in the database and then add the item to the database. The database recited by Claim 20 is a third party database that is searched and updated according to the claimed invention, thus allowing the search and update steps to be accomplished with regard to a database supplied by a third party. At least two of the steps of Claim 20, (1) searching for an item within a database and (2) adding the item to the database, are clearly within at least the computer software and hardware technological arts and thus recite technological limitations in the body of Claim 20, contrary to the allegation of the Examiner. Therefore, Claim 20 is directed to statutory subject matter and Claims 21-26 dependent therefrom are directed to statutory subject matter for at least this reason and the rejections of these claims should be withdrawn.

With respect to independent Claims 1, 10, 17, and 20, there is more recited by each of these claims than a mere implication of employing specific technologies to perform the recited functions and steps. The terms "database" and "knowledge base", as currently used, did not even exist prior

to the advent of today's computer industry. And, given the current state of database and knowledge base technology it is no more necessary to explicitly disclose the technology used for their implementation than it is to disclose that to perform its function an electrical apparatus (such as a computer system) requires a power source. Anyone ordinarily skilled in the art of database and knowledge base technology knows that computer hardware and software are required in order to implement the procurement systems of Claims 1, and 10, as well as the methods of Claims 17 and 20. In fact, it is well understood that knowledge bases require a computer-based implementation comprising a rules engine, that databases require specialized software commonly known as database systems and both require auxiliary storage hardware such as magnetic and optical media for long term or persistent storage of their respective rules and data. In order to claim a database, no one expects the disclosure to include a description of the low level software and hardware required to create and store the database and transport parts of the database from the storage to a computer's memory so that the data can be used by the invention claiming the database. All of this is assumed to be present in the underlying technology which supports a database.

Based on the foregoing arguments, the recited limitations of independent Claims 1 and 10 and steps of independent method Claims 17 and 20 clearly avoid the Bowman problem, are clearly within computer system hardware and software technological arts and thus recite technological limitations, contrary to the allegation of the Examiner. Therefore, independent Claims 1, 10, 17 and 20 and Claims 2-9, Claims 11-16, 18-19, and 21-26, respectively dependent therefrom, are directed to statutory subject matter and the rejections should be withdrawn.

2. Claims 1-3, 8-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Povilus (U.S. 5,740,425) in view of Dudle et al. (U.S. 5,570,291 hereinafter "Dudle).

I. Independent Claims 1, 10, 17 and 20.

A. Claim 1

The Examiner alleges that Povilus discloses a procurement system comprising, *inter alia*, a fulfillment system (col. 44, lines 23-28).

Applicants respectfully traverse. Povilus teaches a data structure and method for publishing electronic and printed product catalogs as well as a channel publisher as the publisher of the catalogs. Nowhere does Povilus disclose that a channel publisher functions as or is "a fulfillment system for communicating between said buyer and said supplier", as recited by present Claim 1. Povilus teaches only that a "channel publisher" creates a catalog database using a set of predefined steps that extract a complete definition of all of a manufacturer's products at a normalized SKU level (col. 44, lines 27-50) and multiple renditions of both electronic and printed, single and multi-manufacturer catalogs can be created, maintained and published by the channel publisher using the data structure and method taught by Povilus (Abstract).

At the reference cited by the Examiner to support the Examiner's allegation that a channel publisher is a fulfillment system, (col. 44, lines 23-28), Povilus teaches as an example a manufacturer that has traditionally used its own internal graphics arts group to create printed catalogs and promotional materials that now wishes to work with a channel publisher to create a catalog database, i.e., a manufacturer is outsourcing creation of its catalog. This catalog database is published and released in printed form and in machine readable form, such as a CD, and once released the channel publisher is not involved in any fulfillment activities directed to communications between a buyer and a supplier.

Since Povilus does not teach a fulfillment system and Dudle does not cure this deficiency of Povilus, the Examiner has failed to make out a *prima facie* case of obviousness with regard to independent Claim 1 and the rejection should be withdrawn. Claim 1 is therefore allowable.

B. Claim 10

The Examiner admits that Povilus fails to teach a specifying procedure, said procedure invoked when the desired item cannot be located within a catalog database, and cites Dudle as teaching a system that allows customers to create custom orders for special items in addition to a catalog of off-the-shelf products (col. 8, lines 32-36), which can then be added to the database for processing future orders (col. 10, lines 31-34). The Examiner alleges that it would have been obvious to combine Povilus' method for publishing electronic catalogs with Dudle's custom product ordering system so as to provide a customer with an item specifying procedure for an item not found in a catalog, thereby increasing customer satisfaction.

Applicants respectfully traverse. Applicants reiterate and augment their arguments presented in the response filed on October 29, 2002, namely, that Dudle does not teach an item specifying procedure as recited in Claim 10 that is invoked when the desired item cannot be located in a catalog database and that Dudle only teaches customizing features of known products, forms for example, with a pre-determined list of specifiable options and only within pre-determined ranges for each such option. With regard to a catalog of off-the-shelf products, the only items inventoried by the system taught by Dudle are finished goods corresponding to previously specified custom orders for given customers or ready-made office supplies (col. 6, lines 54-58) and Dudle does not teach a generally available catalog that includes these customized finished goods. Only ready-made office supplies are included in the catalog taught by Dudle. Dudle teaches that forms that have already been

produced for a customer can be warehoused at a plant or distribution facility in accordance with a warehousing agreement (col. 6, lines 54-58) and Dudle does not teach that these custom products are included in a generally available catalog but only teaches that office supplies such as staplers are offered for resale in a catalogue (col. 8, lines 35-36).

Dudle teaches an item specifying procedure that is described beginning at col. 8, line 54 et seq and results in a production order for a custom product. That the item specifying procedure of Dudle is constrained to known pre-determined products having known pre-determined options is supported in Dudle's disclosure at col. 11, line 52 through col 12. line 60 where Dudle explicitly teaches that Dudle's validation process prevents the sales representative from selecting features for a type of business form that cannot be priced or manufactured. Contrary to the allegation of the Examiner that the example of validation given in Dudle only ensures that all features are logically consistent, Applicants assert that Dudle explicitly teaches a system only allows selection from a menu of known pre-determined form or item types having only known customizable features, e.g., "The screens are designed to highlight and/or restrict the user to only those menu options that are available based on previous inputs". Finally, Block 141 of FIG. 4 shows the sales site computer validating an item specification before it is transmitted to obtain an estimate and at col. 11, line 42-45 each plant validates every order specification it receives, just in case an inconsistent product specification slips through the sales site computer. These various validations of a specification taught by Dudle are multiple validation checkpoints in the specification process intended to assure that only those items which are known and have known options within known ranges are specified by the item specifying procedure. Dudle's teaching thus is intended to make it impossible to specify an item that is not known. The Examiner's argument that a given plant can only produce the

products that it is set up for, while obviously true, does not invalidate the fact that Dudle only teaches customizing known pre-determined products within a list of known pre-determined options and only within a range of pre-determined values for these options.

Since Dudle does not teach an item specifying procedure to be invoked when the desired item *cannot be located* within a catalog database but only a specifying for known pre-determined items, the admitted deficiency of Povilus is not overcome by the teaching of Dudle and the Examiner has failed to make out a *prima facie* case of obviousness with regard to independent Claim 10 and the rejection should be withdrawn. Claim 10 is therefore allowable.

C. Claim 17

The Examiner admits that Povilus fails to teach processing a request for a special item not located within the catalog database using the predetermined relationship but cites Dudle as teaching a customer or sales representative processing a custom order for a business form that is not located in the electronic database (not a catalog database as recited by Claim 17), such as creating the form using form design software, and that application of standard rules and procedures would apply to any custom form being designed.

Applicants respectfully traverse. Applicants assert that the Examiner does not address how standard rules and procedures correspond to predetermined relationships in a catalog database. Further, Applicants assert that the Examiner is in effect admitting that Dudle teaches standard rules and procedures for form design that correspond to known pre-determined form types having known pre-determined options with known pre-determined ranges of values for these options and, except for making a specification explicit, the meets and bounds of all specifiable forms are known and it is these that would be included in any catalog database and not the detailed specifications of individual

customer orders, which would unnecessarily clutter up a catalog database (why would such a catalog include a plurality of individual form sizes, for example, rather a single entry for a form having an allowable range of sizes.

Based on the foregoing arguments, Applicants assert that the Examiner has failed to make out a *prima facie* case of obviousness, the rejection should be withdrawn, and Claim 17 is allowable.

D. Claim 20

The Examiner alleges that Dudle teaches a system that allows customers to create custom orders for special items in addition to a catalog of off-the shelf products (col. 8, lines 32-36), which can then be added to the database for processing future orders (col. 10, lines 31-34).

Applicants respectfully traverse. Dudle teaches warehousing goods, corresponding to previously produced special orders *for a given customer (*which are not available to anyone but the given customer) according to a warehousing agreement (col. 6, line 51 et seq) and does not teach that these warehoused goods are added to a catalog as off-the-shelf products. Dudle only teaches that office supplies such as staplers are offered in a catalog for resale along with the release order, i.e., the off-the-shelf products are offered for resale when the warehoused goods are ordered to be released to the customer. Further, at the Office Action's cited location of col. 10, lines 31-34, Dudle does not teach, as the Examiner alleges, creation of custom orders for special items in addition to a catalog of off-the shelf products, such that the custom order can be added to the database for processing future orders. Dudle teaches creating and storing a form template comprising a number of fields for use in later form specification sheets thereby reducing the need to re-enter data. The template taught by Dudle thus also represents a known item since the customer created it using a system that only allows pre-determined products with pre-determined customizable features and therefore a template does not

represent an item specifying procedure for an item not found in a catalog. Further, there isn't even a catalog of customizable products taught by Dudle. Customers and sales agents pick products from a known pre-determined list or menu of form types that is presented to them and are directed by the system of Dudle to allowable customization options for the form which are also known pre-determined lists or menus and having a range of values specified for the customizations which is proscribed within known limits (see discussion above for Claim 10 for supporting references).

Applicant assert that the Examiner has not made out a *prima facie* case of obviousness, the rejection should be withdrawn, and Claim 20 is allowable.

II. Dependent Claims 2-9, 11-16, 18-19 and 21-26.

In view of the remarks of paragraph I above, it is respectfully submitted that since independent Claims 1, 10, 17, and 20 are allowable, therefore Claims 2-9, 11-16, 18-19 and 21-26 respectively dependent therefrom are allowable for at least this reason.

3. Claims 4-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Povilus in view of Dudle and further in view of Conklin et al. (U.S. 6,338,050 hereinafter "Conklin").

The Office Action alleges that Povilus substantially discloses the invention.

As argued above in I with respect to Claim 1, Povilus does not teach a fulfillment system but only a channel publisher of electronic and print catalogs and Dudle does not cure this deficiency of Povilus.

Therefore, the Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness, the rejection should be withdrawn and instant claims 4-7 are allowable at least due their dependence from allowable Claim 1.

4. Claim 7 is rejected under 35 USC 103(a) as being unpatentable over Povilus and Dudle and further in view of Conklin et al.

The Office Action alleges that Povilus and Dudle teach all the limitations of Claim 2.

As argued above with respect to Claims 1, and 4-7 these claims are allowable because Povilus fails to teach a fulfillment system and Dudle does not cure this deficiency of Povilus. Nor does Conklin remedy this deficiency of the combination of Povilus and Dudle with respect to instant claim 7.

Therefore, the Applications respectfully submit the Examiner has not made out a *prima facie* case of obviousness, the rejection should be withdrawn, and instant claim 7 is allowable at least due to its dependence from allowable Claim 1.

5. Claims 1-3 and 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Povilus in view of Gardner and further in view of Dudle.

The Office Action alleges that Povilus discloses a procurement system comprising *inter alia* a fulfillment system.

As argued above with respect to Claim 1, Povilus fails to teach a fulfillment system and Gardner fails to cure this deficiency of Povilus. Further, as argued above, Dudle also fails to remedy this deficiency of the combination of Povilus and Gardner.

Therefore, the Applications respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness, the rejection should be withdrawn, and instant independent Claim 1 is allowable and Claims 3 and 7-9 dependent therefrom are allowable for at least this reason.

Conclusion

In view of the foregoing amendments and remarks, all stated rejections of the Office Action have been overcome and this Application is in condition for allowance. Early notice to that effect is earnestly solicited.

If any issues remain which may be best resolved through a telephone communication, the Examiner is requested to kindly telephone the undersigned at the local, Washington D.C. telephone number listed below.

Respectfully submitted,

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